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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/072,863 | 02/09/2002 | Wayne K. Kaim | KAIMAS-6 | 2420 |
| 20455 | 7590 | 08/10/2004 | EXAMINER | |
| LATHROP & CLARK LLP 740 REGENT STREET SUITE 400 P.O. BOX 1507 MADISON, WI 537011507 | | | SNIDER, THERESA T | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1744 | |

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/072,863

Applicant(s)

KAIM, WAYNE K.

Examiner

Theresa T Snider

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 07 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5 and 9-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12 and 19-22 is/are allowed.
- 6) ☒ Claim(s) 1,5,9-11,13-18,23-25,27 and 28 is/are rejected.
- 7) ☒ Claim(s) 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claim 1 directed to an allowable product. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claims 9-12, directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, now subject to being rejoined. Claims 9-12 hereby rejoined and fully examined for patentability under 37 CFR 1.104.

Since all claims previously withdrawn from consideration under 37 CFR 1.142 have been rejoined, the restriction requirement made in the Office action mailed on 3/4/2004 is hereby withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 5, 9-18 and 23-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Exemplary of such:

Claims 1 and 5, it is unclear as to whether one is intending to set forth a Jepson claim, a typical improvement claim. The claim usually begins with 'In a' and after setting forth the 'old' material, is followed by 'wherein the improvement comprises.

Claim 9, lines 13 and 16, 'buffing' should be inserted after 'second';

Line 16, 'the web' should be replaced with 'a web'.

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Claim 23, line 1, it is unclear as to whether the claim is supposed to a Jepson claim or not.

Claim 27, line 14, 'the web' should be replaced with 'a web';

Line 14, 'buffing' should be inserted after 'second'.

Claim 28, line 2, 'buffing' should be inserted after 'second'.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 5 and 23 rejected under 35 U.S.C. 103(a) as being unpatentable over The admitted State of the Prior Art as set forth in the preamble of the Jepson Claim(hereafter ASPA) in view of Hanish and Best & Co.

ASPA discloses a similar apparatus however fails to disclose the claimed roll structure.

Hanish discloses a buffing roll having a hollow core with a core surface and mounted for rotation between stub shafts (fig. 1, #1,4).

Hanish discloses a jacket positioned about the surface wherein the jacket is held, not bonded, to the surface (col. 1, lines 27-31 and col. 2, lines 68-71 and 88-95).

Hanish discloses the jacket being a cloth or fabric however fails to disclose any specifics (col. 1, lines 27-28). Best & Co. discloses the use of cloth and fabrics on a buffing roll, wherein the cloth and fabric is felt or wool, materials known to be soft and have projecting fibers (see document). It would have been obvious to one of ordinary

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skill in the art to provide the cloth/fabric of Best & Co. in Hanish to allow for the provision of a jacket with a 'smooth polishing surface'.

It would have been obvious to one of ordinary skill in the art to provide the roll of Hanish in view of Best & Co. in ASPA to provide for a roll that is used with a moving web that will allow for cleaning without scratching/tearing of the web.

With respect to claims 16 and 24, Hanish discloses the jacket extending continuously from one point to another around the outer surface (col. 2, lines 58-59, fig. 3, #7).

With respect to claims 17 and 25, it would have been obvious to one of ordinary skill in the art to determine the most appropriate relative core dimensions in ASPA in view of Hanish and Best & Co. to allow for the most effective cleaning of a web.

Response to Amendment

6. The remarks submitted 6/7/2004 state that a drawing change was included however there was no drawing change present.

Allowable Subject Matter

7. Claims 12, 19-22 and 28 are allowed.

8. Claim 26 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claim 1, 9 and 27 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

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10. Claims 10-11, 13-15 and 18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

11. Applicant's arguments filed 6/7/2004 have been fully considered but they are not persuasive. Applicant urges that Hanish fails to disclose stub shafts that the core rotates about. This is not deemed persuasive because the bearing sleeves of figure 1, #4 provides a stub shaft for the roll to rotate. As evidenced by Bashyam, a stub shaft can have a bore passing there through (fig. 2, #35).

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

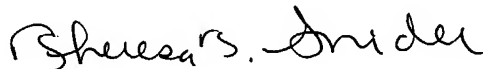
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advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theresa T Snider whose telephone number is (571) 272-1277. The examiner can normally be reached on Monday-Wednesday-Friday (6:30am-3:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Warden can be reached on (571) 272-1281. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**THERESA T. SNIDER
PRIMARY EXAMINER**

Theresa T Snider
Primary Examiner
Art Unit 1744

8/9/2004